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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,695	03/19/2004	Rosa Cuberes Altisen	785-011732-US (PAR)	9152
2512	7590	01/10/2006	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			NOLAN, JASON MICHAEL	
			ART UNIT	PAPER NUMBER
			1626	
DATE MAILED: 01/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/804,695	Applicant(s) ALTISEN ET AL.	
	Examiner Jason M. Nolan, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

**Claims 1-12** are currently pending in the application.

#### ***Priority***

Acknowledgement is made of Applicant's claim for priority via foreign patent application Spain 2004 00362, filed on February 16, 2004.

#### ***Information Disclosure Statement***

Applicant's information disclosure statements (IDS), filed on August 22, 2005 and October 25, 2004 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

#### ***Response to Restriction***

Applicant's election without traverse of Group I, Claims 1-9, drawn to products of the formula I and I' wherein R<sup>1-4</sup> are as defined is acknowledged. Applicants request not to restrict within the elected group and to examine all compounds of Group I is acknowledged and agreed upon. Group II, Claims 10-12, drawn to methods of using the compounds of formula I and I' is withdrawn from consideration.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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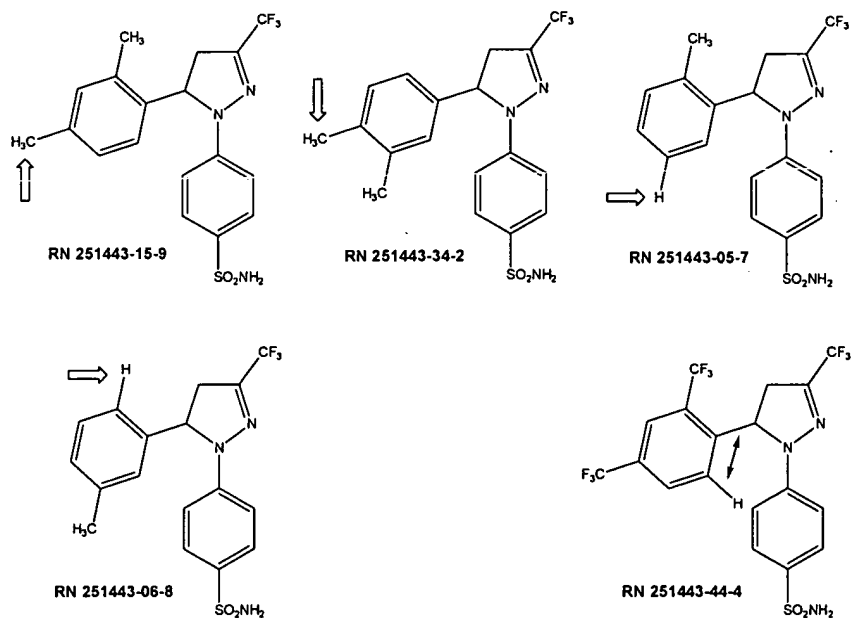
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-9** are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cuberes-Altisent *et al.* (WO 99/62884, 1999, see US Patent 6,353,117), taken alone.

***Determination of the scope and content of the prior art (MPEP § 2141.01)***

Cuberes-Altisent *et al.* teaches the following compounds shown below:



These compounds taught by Cuberes-Altisent *et al.* are useful for the treatment of inflammation, neoplastic disorders, and angiogenesis-mediated disorders.

***Ascertainment of the difference between the prior art and the claims (MPEP § 2141.02)***

The difference between the prior art of Cuberes-Altisent *et al.* and the compounds of formula I in the instant application are pointed out in the scheme above, showing the positioning of the methyl substituents on the phenyl ring (all with respect to the heterocyclic substituent). Formula I of the instant application is substituted at the ortho(2)- and meta(5)-positions of the phenyl. Compounds RN 251443-15-9 and RN 251443-05-7 have ortho(2)-position methyl groups and compounds RN 251443-34-2 and RN 251443-06-8 have meta(5)-position methyl groups. The arrows indicate that there is either a hydrogen in the spot where a methyl is for formula I (RN 251443-05-7 and RN 251443-06-8) or where the methyl group is in a different position than in formula I (RN 251443-14-9 and RN 251443-34-2).

The difference between the prior art of Cuberes-Altisent *et al.* and the compounds of formula I' in the instant application is the positioning of the phenyl substituents. In formula I' of the instant application, both R<sub>3</sub> and R<sub>4</sub> are meta with respect to the heterocyclic ring and are limited to being, equal or different, a C<sub>1-6</sub> alkyl group, of which at least one is substituted with at least one halogen. Compound RN 251443-44-4, taught by Cuberes-Altisent *et al.* meets this criterion, however it is a positional isomer, such that the CF<sub>3</sub> groups are ortho- and para- to the heterocyclic substituent. The arrow indicates the positional difference between this compound and the compounds of formula I'.

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***Finding of prima facie obviousness--rational and motivation (MPEP § 2142-2413)***

One skilled in the art would have found the claimed compound prima facie obvious because it is well established that the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. *In re Wood*, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and *In re Lahr*, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (i.e. pharmacological use).

One skilled in the art would have found the claimed compound prima facie obvious because it is well established that nothing unobvious is seen in substituting the known claimed isomers, as taught by Cuberes-Altisent *et al.*, since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. *In re Norris*, 84 USPQ 458 (1950).

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

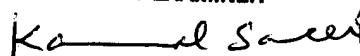
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason M. Nolan, Ph.D.  
Examiner  
Art Unit 1626

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER

*for*   
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626  
Date: January 6, 2006